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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/444,968	11/22/1999	PAUL MARIE VANDEVOORDE	ACO2587PIUS	9305

7590 05/13/2003  
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EXAMINER

BISSETT, MELANIE D

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 05/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/444,968	<b>Applicant(s)</b> VANDEVOORDE ET AL.	
	<b>Examiner</b> Melanie D. Bissett	<b>Art Unit</b> 1711	

-- **Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) ☒ Responsive to communication(s) filed on 10 February 2003.

2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) ☒ Claim(s) 1-17 is/are pending in the application.

4a) Of the above claim(s) 7-11 and 13-17 is/are withdrawn from consideration.

5) ☒ Claim(s) 6 is/are allowed.

6) ☒ Claim(s) 1-5 and 12 is/are rejected.

7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☒ All   b) ☐ Some \*   c) ☐ None of:

1. ☒ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) <input type="checkbox"/> Notice of References Cited (PTO-892) 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s) _____ 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) 6) <input type="checkbox"/> Other: _____
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Art Unit: 1711

### DETAILED ACTION

1. The rejections based on 35 USC 102 and 35 USC 103 have been maintained.
2. This application contains claims 7-11 and 13-17 drawn to an invention nonelected with traverse in Paper No. 7. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144). See MPEP § 821.01.

### *Claim Rejections - 35 USC § 102*

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
4. Claims 1-2, 4-5, and 12 are rejected under 35 U.S.C. 102(e) as being anticipated by Ho.
5. From a prior Office action:
  5. Ho discloses a composition to be used as a clearcoat (col. 24 lines 26-28) comprising 2-butyl-2-ethyl-1,3-propanediol, an isocyanate, and two polyol compounds (see Table 5). Polyol IV of the composition in example 8 is a carbinol-terminated siloxane having an OH equivalent of 98, and Polyol I of the example is a polyester diol with an OH equivalent of 72.9 (see Table 1). The propanediol compound fits the applicant's formula of claim 1, where R is n-butyl. Based on the weight of the combined polyols, the propanediol compound comprises ~15% by weight of the composition. The composition also comprises methyl ethyl ketone, a volatile organic solvent. Thus, the combination present in example 8 for use in a coating composition anticipates the applicant's claimed coating composition.
6. Claims 1-3, 5, and 12 are rejected under 35 U.S.C. 102(e) as being anticipated by Mayer et al.
7. From a prior Office action:

Art Unit: 1711

7. Mayer discloses coating compositions for basecoats and clearcoats combining acrylate resins and urethane resins (col. 15 lines 56-67), where the acrylate resin has an OH number of 40-200 mg KOH/g (col. 4 lines 39-45) and the urethane resin is a product of a polyisocyanate and an alcohol such as 2-butyl-2-ethylpropane-1,3-diol (col. 12 lines 18-25; col. 13 lines 29-40; col. 22 lines 5-23). The coatings have VOC values of  $\leq 2.8$  lbs/gal (335.5 g/L) (col. 4 lines 11-17). In the broadest interpretation of the claims, compositions containing reaction products of the claimed components would read on a coating composition comprising the components. Thus, it is the examiner's position that Mayer et al. anticipates the present claims.

### ***Claim Rejections - 35 USC § 103***

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

9. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ho.

10. From a prior Office action:

10. Ho applies as above, failing to exemplify the use of an acrylate polymer with the composition of the invention. The example presented by Ho does not teach the use of an acrylic polymer; however, Ho notes the possible addition of a polyacrylate polyol to the coating composition to improve gloss retention and decrease drying time of the coating (col. 16 lines 18-34). Therefore, it would have been prima facie obvious to include an acrylate polyol in the exemplified coating composition to improve gloss retention of the coating.

### ***Allowable Subject Matter***

11. Claim 6 is allowed.

12. The following is a statement of reasons for the indication of allowable subject matter:

13. The reference teaches a coating composition comprising two hydroxy-group containing polymers, a polyisocyanate, and a diol fitting the applicant's formula of claim

1. Although polyester and polyurethane polyols are taught as possible hydroxy-group

containing polymers or additives, the reference does not teach the polymers derived from the specified diol combined with the composition. It is the examiner's position that the polymer derived from the diol, when added to the composition of the diol, isocyanate, and polyol, is novel and unobvious over the prior art.

### ***Response to Arguments***

14. It is the examiner's position that Ho's final coating composition would read on the present claims, since the composition uses the applicant's claimed components to form the coating. The applicant has not limited the process for forming the coating or the reaction state of the components in the coating composition. The applicant also has not excluded other reactants from the composition. Thus, a coating composition comprising reaction products of a film-forming polymer, a polyisocyanate, and a diol would anticipate a coating composition comprising the components. It is noted that Ho cites the final product of the invention as a coating composition useful for clearcoats.

15. In response to the applicant's arguments that the claim language cannot be expanded to include any and all possible materials the words might read on, it is the examiner's position that the claims must be interpreted in the broadest sense. A "coating composition" includes all materials used to form a coating, which in this case includes the initial reactants.

16. Regarding the applicant's arguments that nothing in Ho discloses the coating composition as separate, non-reacted components, it is first noted that the claim does not limit the coating composition to separate, non-reacted components. It is also noted

Art Unit: 1711

that the applicant's examples suggest coating compositions comprising the reaction products of the claimed components. The short pot lives of the compositions suggest that reaction begins when the components are first mixed.

17. In the broadest interpretation of the claim, a "coating composition" would encompass all compositions that have the ability to coat at least a small portion of a substrate. The moment reactants are mixed, the mixture becomes a "coating composition", since this is the intent of the mixture. Additionally, it is not intended to coat substrates with Ho's intermediate composition; however, because the mixtures have the capability to coat a substrate simply by contacting the mixture with a substrate, the intermediates can be considered a "coating composition." Sufficient evidence has not been provided to suggest that such a composition would not coat at least a portion of a substrate. It is noted that the applicant has not defined "coating composition" to exclude low-molecular-weight compositions. Since the compositions of the reference inherently teach compositions capable of coating at least part of a substrate, motivation for using the composition as such is not needed. It is noted that the rejection of claim 1 has been made under 35 USC 102 and not 35 USC 103.

18. In response to the applicant's arguments that the unreacted components would have different properties than the reacted product, it is acknowledged that unreacted, separate components would have different properties. However, the claims do not limit the compositions to unreacted components, and the applicant's examples show rapid reaction of the claimed components.

Art Unit: 1711

19. Regarding the applicant's arguments that Ho does not teach the claimed hydroxyl values, it is noted that Ho clearly suggests the use of carboxyl-functional diols having equivalent weights of 60-2000 in the invention (col. 10 lines 23-31). By the applicant's calculations, this results in hydroxyl numbers of 28-935 mg KOH/g of polyol.

20. In response to the applicant's arguments that Mayer does not disclose the polyol of the formula in claim 1, it is the examiner's position that such a polyol was used to form the coating composition, and as such, the coating composition comprises the polyol.

21. Regarding the applicant's arguments that none of components (a)-(h) and/or (a)-(g) of part A corresponds to the diol of the formula in claim 1, it is noted that claim 3 limits the film forming polymer and not the specific diol of the formula in claim 1. Ho teaches including polyacrylate polyols to improve gloss retention and reduce drying time. Therefore, it has been the examiner's position that it would have been prima facie obvious to include polyacrylate polyols in the coating compositions of Ho to improve gloss retention and reduce drying time. The acrylate polymers are taught to have hydroxyl equivalent weights of 200-8000, resulting in hydroxyl values of 7-280 mg KOH/g polyol.

22. In response to the applicant's arguments that Ho's compositions do not teach the separate components of claim 1, the examiner notes the arguments above, paragraphs 13-17.

**Conclusion**

23. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melanie D. Bissett whose telephone number is (703) 308-6539. The examiner can normally be reached on M-F 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (703) 308-2462. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.



Art Unit: 1711

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

mdb  
April 25, 2003

James J. Seidleck  
Supervisory Patent Examiner  
Technology Center 1700